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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

JEFFRY J. GRAINGER et al.

Application No.: 09/919,787

Filed: July 31, 2001

For: COMPUTER IMPLEMENTED  
METHOD OF GENERATING  
INFORMATION DISCLOSURE  
STATEMENTS

Examiner: Unassigned

Art Unit: 2161

INFORMATION DISCLOSURE  
STATEMENT UNDER 37 CFR §1.97 and  
§1.98

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

The references cited on attached form PTO/SB/08A and PTO/SB/08B are being called to the attention of the Examiner. Copies of the references are enclosed. It is respectfully requested that the cited references be expressly considered during the prosecution of this application, and the references be made of record therein and appear among the "references cited" on any patent to issue therefrom.

As provided for by 37 CFR 1.97(g) and (h), no inference should be made that the information and references cited are prior art merely because they are in this statement and no

JEFFRY I. GRAINGER et al.  
Application No.: 09/919,787

PATENT

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Respectfully submitted,



Chad R. Walsh  
Reg. No. 43,235

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Sheet	3
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3

of

Application Number

**Complete if Known**

09/919,787

Filing Date

July 31, 2000

**First Named Inventor**

Grainger et al.

**Group Art Unit**

2161

Examiner Name

Unassigned

Attorney Docket Number

020313-000520US

## U.S. PATENT DOCUMENTS

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Application Number 09/919,787  
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Group Art Unit 2161  
Examiner Name Unassigned  
Attorney Docket Number 020313-000520US

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		Office <sup>3</sup>	Number <sup>4</sup>	Kind Code <sup>5</sup> (if known)				
	1.	WO	01/08031	A2	Morris et al.	02-01-2001		

## **OTHER PRIOR ART -- NON PATENT LITERATURE DOCUMENTS**

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	32	Computer Patent Annuities, "Welcome to CPA" [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: <a href="http://www.cpajersey.com/cpajersey/maincombo.htm">http://www.cpajersey.com/cpajersey/maincombo.htm</a> > 1 page total.	
	33	Computer Patent Annuities, "IP Management Software Services From CPA" [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: <a href="http://www.cpajersey.com/cpajersey/mis1.htm">http://www.cpajersey.com/cpajersey/mis1.htm</a> > 1 page total.	
	34	Computer Patent Annuities, "Memotech IP Suite Features" [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: <a href="http://www.cpajersey.com/cpajersey/mis2.htm">http://www.cpajersey.com/cpajersey/mis2.htm</a> > 3 pages total.	
	35	Computer Patent Annuities, "Technical Specifications" [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: <a href="http://www.cpajersey.com/cpajersey/mis3.htm">http://www.cpajersey.com/cpajersey/mis3.htm</a> > 2 pages total.	
	36	Computer Patent Annuities, "CPA Direct" [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: <a href="http://www.cpajersey.com/cpajersey/welcome.htm">http://www.cpajersey.com/cpajersey/welcome.htm</a> > 18 pages total.	
	37	CPI Computer Packages Inc. [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: <a href="http://www.computerpackages.com/">http://www.computerpackages.com/</a> > 1 page total.	
	38	CPI Computer Packages Inc., "Products and Services" [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: <a href="http://www.computerpackages.com/products.asp">http://www.computerpackages.com/products.asp</a> > 1 page total.	
	39	CPI Computer Packages Inc., "Patent System" [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: <a href="http://www.computerpackages.com/patent.asp">http://www.computerpackages.com/patent.asp</a> > 2 pages total.	
	40	CPI Computer Packages Inc., "Trademark System" [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: <a href="http://www.computerpackages.com/trademar.asp">http://www.computerpackages.com/trademar.asp</a> > 2 pages total.	
	41	CPI Computer Packages Inc., "Patent Annuity Payment Service" [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: <a href="http://www.computerpackages.com/annuity.asp">http://www.computerpackages.com/annuity.asp</a> > 1 page total.	
	42	CPI Computer Packages Inc., "What's New" [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: <a href="http://www.computerpackages.com/whatsnew.asp">http://www.computerpackages.com/whatsnew.asp</a> > 2 pages total.	

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Application Number	09/919,787
Filing Date	July 31, 2000
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Group Art Unit	2161
Examiner Name	Unassigned
Attorney Docket Number	020313-000520USTechnology Center 2100

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	43	CPI Computer Packages Inc., [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: <a href="http://www.computerpackages.com/">http://www.computerpackages.com/</a> > 1 page total.	
	44	CPI Computer Packages Inc., "CPI News" Spring 2001 [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: <a href="http://www.computerpackages.com/">http://www.computerpackages.com/</a> > 4 pages total.	
	45	Patent Information Services of Computer Packages Inc. [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: <a href="http://www.patentinfoserv.com/">http://www.patentinfoserv.com/</a> > 1 page total.	
	46	EFS Electronic Filing System "Submission Manual ePAVE" United States Patent and Trademark Office [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: <a href="http://www.uspto.gov/">http://www.uspto.gov/</a> > 157 pages total.	
	47	Intuit Press Release: "E-Filing Completely Paperless With Quicken TurboTax Now Even Easier To Get A Tax Refund Fast" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: <a href="http://www.intuit.com/company/press_releases/2001/01-12c.html">http://www.intuit.com/company/press_releases/2001/01-12c.html</a> > 2 pages total.	
	48	Intuit "Electronic Filing software with ProSeries/1040 and individual states" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: <a href="http://www.proseries.com/efiling/index.shtml">http://www.proseries.com/efiling/index.shtml</a> > 2 pages total.	
	49	Intuit "TurboTax Premier for Tax Year 2001" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: <a href="http://www.shopintuit.com/qstore/ProdInfo.asp?BaseCode=TTPRW2001&amp;">http://www.shopintuit.com/qstore/ProdInfo.asp?BaseCode=TTPRW2001&amp;</a> > 6 pages total.	
	50	LegalStar® Product Solicitation/Brochure entitled "IP Legal Dock Pro Document Management Software for IP Law" ©1999, LegalStar®, P.O. Box 415, Williamsville, NY 14231-0415, 5 pages total	
	51	IPSearchEngine.com [retrieved on 2001-10-11]. Retrieved from the Internet: <URL: <a href="http://www.ipsearchengine.com/index.asp?">http://www.ipsearchengine.com/index.asp?</a> > 17 pages total.	
	52	IRS "Electronic Services" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: <a href="http://www.irs.gov/plain/elect_svs/index.html">http://www.irs.gov/plain/elect_svs/index.html</a> > 2 pages total.	
	53	IRS "Electronic Services IRS e-file for Individual Taxpayers" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: <a href="http://www.irs.gov/plain/elect_svs/efile-ind.html">http://www.irs.gov/plain/elect_svs/efile-ind.html</a> > 2 pages total.	
	54	IRS "Electronic Services IRS e-file for IBusinesses" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: <a href="http://www.irs.gov/plain/elect_svs/efile-bus.html">http://www.irs.gov/plain/elect_svs/efile-bus.html</a> > 2 pages total.	
	55	IRS "Electronic Services Approved IRS e-file for IBusiness Providers" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: <a href="http://www.irs.gov/plain/elect_svs/efile-abp.html">http://www.irs.gov/plain/elect_svs/efile-abp.html</a> > 3 pages total.	
	56	PatentWizard, Inc. [retrieved on 2001-24-10]. Retrieved from the Internet: <URL: <a href="http://www.patentwizard.com/">http://www.patentwizard.com/</a> > 3 pages total.	
	57	PatentWizard Inc. "About PatentWizard" [retrieved on 2001-24-10]. Retrieved from the Internet: <URL: <a href="http://www.patentwizard.com/htmls/about.htm">http://www.patentwizard.com/htmls/about.htm</a> > 6 pages total.	
	58	PCT Easy "FAQ" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://pcteasy.wipo.int/en/help/faq.htm">http://pcteasy.wipo.int/en/help/faq.htm</a> > 7 pages total.	

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Attorney Docket Number	020313-000520US

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	59 /	PerfectLaw Software "About the Company" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://www.perfectlaw.com/about.the.htm">http://www.perfectlaw.com/about.the.htm</a> > 2 pages total.	
	60 /	PerfectLaw Software "DocPro" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://www.perfectlaw.com/docpro.htm">http://www.perfectlaw.com/docpro.htm</a> > 8 pages total.	
	61 /	PerfectLaw Software "Front Office Software" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://www.perfectlaw.com/frontoff.htm">http://www.perfectlaw.com/frontoff.htm</a> > 2 pages total.	
	62 /	PerfectLaw Software "Back Office Software" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://www.perfectlaw.com/Backoff.htm">http://www.perfectlaw.com/Backoff.htm</a> > 1 pages total.	
	63 /	PerfectLaw Software "Case & Matter Management Docket Scheduling" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://www.perfectlaw.com/docketsch">http://www.perfectlaw.com/docketsch</a> > 2 pages total.	
	64 /	PerfectLaw Software "Case & Matter Management Documents Processing" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://www.perfectlaw.com/docprocessing.htm">http://www.perfectlaw.com/docprocessing.htm</a> > 1 page total.	
	65 /	PerfectLaw Software "Case & Matter Management Custom Information Fields" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://www.perfectlaw.com/customtabs.htm">http://www.perfectlaw.com/customtabs.htm</a> > 1 page total.	
	66 /	PerfectLaw Software "Scheduling and Time Management Reminders and Alarms" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://www.perfectlaw.com/reminders.htm">http://www.perfectlaw.com/reminders.htm</a> > 3 pages total.	
	67 /	PerfectLaw Software "Scheduling and Time Management Printing daily/weekly/monthly calendars" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://www.perfectlaw.com/printing.htm">http://www.perfectlaw.com/printing.htm</a> > 2 pages total.	
	68 /	"Legal Automation Newsletter" Vol. 20, Issue 1, Executive Data Systems, Inc., 2100 Ponce de Leon Blvd., Suite 1200, Coral Gabels, FL 33134, pp. 1-6.	
	69 /	"Legal Automation News" Issue 19.1, Executive Data Systems, Inc., 2100 Ponce de Leon Blvd., Suite 1200, Coral Gabels, FL 33134, pp. 1-4.	

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